



7-7-03

AF
#24
88
7/15/03

"EXPRESS MAIL" MAILING LABEL
NUMBER EV 332039862 US
DATE OF DEPOSIT July 3, 2003
I HEREBY CERTIFY THAT THIS PAPER OR FEE IS BEING
DEPOSITED WITH THE UNITED STATES POSTAL
SERVICE "EXPRESS MAIL POST OFFICE TO
ADDRESSEE" SERVICE UNDER 37 C.F.R. 1.10 ON THE
DATE INDICATED ABOVE AND IS ADDRESSED TO
COMMISSIONER FOR PATENTS, Mail Stop Appeal Brief-
Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Christine Spare
(TYPED NAME OF PERSON MAILING PAPER OR FEE)
Christine Spare
(SIGNATURE OF PERSON MAILING PAPER OR FEE)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:)
Richard L. Palinkas) Examiner: B. Pezzlo
Title: SIDE BEARING PAD) Group Art Unit: 3683
Serial No.: 09/407,053)
Filed: September 27, 1999) (Our Docket No. 6350-05)

Hartford, Connecticut, July 3, 2003

Mail Stop Appeal Brief -Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
JUL 11 2003
GROUP 3600

APPELLANT'S REPLY TO EXAMINER'S ANSWER

Dear Sirs:

In response to the Examiner's Answer mailed May 6, 2003, Appellant respectfully submits the following.

Issue 1

Appellant's claims 1, 3, 5 - 8, 10 -14, 17 and 18 are rejected under 35 U.S.C. § 103(a) based on the combination of the Carlston (U.S. Pat. No. 4,998,997), Magowan (U.S. Pat. No. 136,079), Platkiewicz et al. (U.S. Pat. No. 4,465,799), Curtis et al. (U.S. Pat. No. 5,036,774), and Spencer et al. (U.S. Pat. No. 5,086,707) references.

To support the obviousness rejection under 35 U.S.C. §103(a), the Examiner has combined the bearing pad of the Carlston reference (hereinafter

"Carlston") in combination with the solid toroidal springs of the Magowan reference (hereinafter "Magowan"). To illustrate the combination, the Examiner has created a drawing showing the Carlston bearing pad having the toroidal springs of Magowan inserted therein. The Examiner's drawing purportedly shows "[t]hat the teachings of the prior art can be combined...."¹ In this regard, the Federal Circuit has stated that "[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference".² Accordingly, the Examiner's drawing bodily incorporating the toroidal springs of Magowan into the bearing pad of Carlston is not relevant to the determination of obviousness.

Clearly, the Examiner's fabricated drawing is a product of impermissible hindsight reconstruction. "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention."³ The drawing submitted by the Examiner includes only a portion of the spring assembly of the Magowan reference. The Magowan spring also includes a rubber core A having a central bore *a* that is not included in the Examiner's drawing. If not for hindsight reconstruction based on the Appellant's claimed invention, the combination of the Magowan spring in the Carlston bearing pad would likely include the entire Magowan spring including the central core A. Accordingly, the Examiner's drawing is derived from prohibited hindsight reconstruction because there is no teaching or suggestion in Magowan of the bearing pad shown in the Examiner's drawing.

Further, the Examiner's drawing brings to light the inoperability of the bearing pad of Carlston combined with the solid toroidal springs of Magowan. As shown in the Examiner's drawing, the Carlston bearing pad includes a solid stop 50 disposed in the center openings of the toroidal springs B of Magowan. In this combination, the Magowan spring is laterally restrained on both the inner and outer diameters thereof preventing the spring from deforming when compressed. In contrast, the Magowan spring includes the core A having a "bore, *a*, to permit inward expansion of the India rubber when longitudinally compressed."⁴ Similarly, the Appellant's claimed bearing pad includes toroidal rings 62 having central openings therein allowing inward deformation of the rings 62 upon compression thereof. The Carlston bearing pad, on

¹ See Examiner's Answer, Paper 23, p. 4. l. 9 (May 6, 2003).

² In re Wood and Eversole, 202 USPQ 171, 174 (C.C.P.A. 1979).

³ ATD Corp. v. Lydall Inc., 48 USPQ 2d 1321, 1329 (Fed. Cir. 1998).

⁴ Magowan, col. 1, ll. 22-23.

the other hand, includes the central stop 50 that would prevent a solid spring from deforming as in the Magowan reference and the Appellant's claimed bearing pad. The bearing pad of Carlston is designed to work with the hollow springs 36 and 38 wherein the springs fold and flex outwardly and do not require lateral expansion towards the central stop 50. Thus, the bearing pad assembly derived from the combination of the Carlston bearing pad and the toroidal rings of Magowan would not operate as the claimed invention and is unlikely to function as a spring at all because there is no space provided for the toroidal rings of Magowan to deform upon compression.

Additionally, if the Magowan springs were smaller in diameter such that the toroidal springs could expand inwardly when compressed in the Carlston bearing pad the springs would also be smaller in height and thus would not provide the vertical support required of the bearing pad.

For at least the above-identified reasons, the combination of the Magowan springs with the Carlston bearing pad results in an inoperative bearing pad, and thus there is no reasonable expectation of success in using the combination. "Both the suggestion [for the combination] and the expectation of success must be founded in the prior art, not in the applicant's disclosure."⁵ Here, the claimed invention is not obvious in view of the combination of Carlston and Magowan because there is no suggestion for the combination and no reasonable expectation of success founded in the cited prior art references. Thus, the combination of Magowan and Carlston do not support the above-identified obvious rejections under 35 U.S.C. §103(a) of the Appellant's claimed invention.

Regarding the motivation to combine the references of Carlston and Magowan, Appellant maintains that the partial statement identified by the Examiner from the Magowan reference "whereby is provided a spring having a high degree of elasticity, together with great bearing strength, and which may be manufactured with great economy and consequent cheapness"⁶ is directed to the Magowan spring "composed of a central cylindrical core of India rubber and surrounding rings of the same material..."⁷. Thus, as mentioned above, the Magowan spring includes the central core *and* the surrounding rings, (toroidal springs). Clearly, in this case, the Examiner has used the Appellant's claims as an instruction manual to combine selected features of the prior art to support the obviousness rejection. For the sake of argument only, if the above-identified

⁵ In re Dow Chemical Co., 5 USPQ 2d 1529, 1531 (Fed. Cir. 1988).

⁶ Magowan, col. 1, ll. 11-15.

⁷ Magowan, col. 1, ll. 8-10.

statement directed to the Magowan spring provides the motivation to combine the Magowan spring with the Carlston reference, how is it that the Examiner has selected only the solid toroidal rings from the Magowan spring and deleted the central core of the spring. This alone negates the Examiner's argument as to the alleged motivation to combine the references and provides evidence of the Examiner's use of impermissible hindsight reconstruction to form the obviousness rejection.

Further, the ultimate determination under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious.⁸ In this case, the Examiner has suggested that the motivation to combine the Magowan and Carlston references is "self evident" from the above-identified partial statement of the Magowan reference.⁹ However, the Magowan reference fails to suggest any motivation for, or desirability of, the modifications to the Carlston bearing pad espoused by the Examiner. The above-identified partial statement from Magowan is not a suggestion to insert the solid rings of the Magowan spring into the bearing pad of Carlston in order to provide a bearing pad assembly as recited in Appellant's claims. Thus, a motivation to make the cited combination of a portion of the Magowan spring with the Carlston reference is not "self evident" from the partial statement identified by the Examiner. Accordingly, the Examiner has not identified a motivation to combine the references of Magowan and Carlston sufficient to support the obviousness rejection of claims 1, 3, 5 - 8, 10 -14, 17 and 18 under 35 U.S.C. § 103(a) based on the combination of the Carlston, Magowan, Platkiewicz, Curtis, and Spencer references.

Claims 11 and 12

Claims 11 and 12 of the present application recite a bearing pad assembly having a slip lining attached to first and second housing bore walls of the assembly. None of the Carlston, Magowan, Plakiewicz, Curtis, and Spencer references, nor the combination thereof, teach or suggest a side bearing pad having a slip lining attached to the first and second housing bores as recited in Appellant's claims 11 and 12.

With respect to the Platkiewicz reference, the Examiner has concluded that the slide lining of Platkiewicz could be combined with the Magowan,

⁸ See Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 871, 877 (Fed. Cir. 1983). See also, Carl Schenck, A.G. v. Nortron Corp., 218 USPQ 698, 700 (Fed. Cir. 1983).

⁹ See Examiner's Answer, Paper 23, p. 5. l. 6, May 6, 2003.

Carlston, Curtis and Spencer references to provide the claimed invention. However, the question is not whether the slide lining of Platkiewicz "could be used" as the Examiner has concluded, but whether it was obvious at the time of the invention to combine the teachings of Magowan, Carlston, Platkiewicz, Curtis and Spencer to make the Appellant's claimed invention. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."¹⁰ In this case, the Examiner has determined that the Platkiewicz reference by itself provides a motivation to include a slip lining between the housings of the Carlston bearing pad. However, Platkiewicz does not mention attaching a slip lining to the bore of a housing for a bearing pad for rail cars. The Carlston reference does not mention a slip lining. The mere existence of the slide lining material of Platkiewicz in the prior art is not sufficient to suggest or provide a motivation to combine the Platkiewicz reference with Magowan, Carlston, Curtis and Spencer to render the Appellant's claims 11 and 12 obvious under 35 U.S.C. § 103(a). Again, the Examiner has used impermissible hindsight reconstruction because there is nothing in the references, taken as a whole to teach or suggest the cited combination.

Further neither Curtis nor Spencer teach or suggest slip linings attached to the housing bores as in the Appellant's claimed invention. Curtis teaches spacers or filler material 64, 65 positioned along a forward and rear side of the outside of the sleeve member 62, between the sleeve member and the top cap member 52 for permitting the top cap member to rock about a longitudinal axis with respect to the base portion 60, but prevent forward and aft movement so that hunting control is maintained.¹¹ Spencer teaches self-adjusting spacing members 78 between the cap and base parts. The spacing members will freely move upward and downward with the corresponding movements of the cap member.¹² Accordingly, even if combined, Magowan, Carlston, Platkiewicz, Curtis and Spencer do not teach or suggest the slip linings attached to the housing bores of a bearing pad assembly as recited in Appellant's claims 11 and 12.

Furthermore, the Examiner's assertion that both Curtis and Spencer provide motivation to combine the references since both recognize the wear

¹⁰ Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 43 USPQ 2d, 1294, 1297, (Fed. Cir. 1997).

¹¹ See Curtis, col. 4, ll. 61-68, col. 5, ll. 1-3.

¹² See Spencer et al., col. 3, ll. 22-30.

problem which exists between the housings of bearing pads is not sufficient to render the claimed invention obvious. Thus, the Examiner has not identified any teachings in the Platkiewicz, Curtis or Spencer references sufficient to support the §103(a) rejections. Accordingly, the rejection of claims 11 and 12 under 35 U.S.C. §103(a) as allegedly being unpatentable over Carlston in view of Magowan in view of Platkiewicz and further in view of Curtis and Spencer should be reversed.

Issue 2

The Examiner has rejected claims 15, 19 and 20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Carlston in view of Magowan. All of the arguments presented hereinabove regarding the combination of the Magowan and Carlston references with respect to claim 1 apply equally to claim 15.

Issue 3

The Examiner has rejected claims 21 and 22 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Carlston, Magowan, Platkiewicz, Curtis and Spencer. All of the arguments presented hereinabove regarding the combination of the Platkiewicz, Curtis and Spencer references with respect to claims 11 and 12 apply equally to claims 21 and 22.

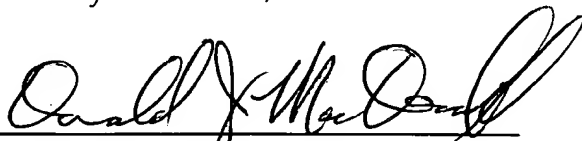
CONCLUSION

In view of the foregoing, Appellant respectfully submits that the rejections of claims 1, 3, 5 - 8, 10 -15 and 17 - 22 under 35 U.S.C. § 103(a) are not warranted. Accordingly, Appellant respectfully requests the Board of Patent Appeals and Interferences to reverse the rejections in the present case and allow claims 1, 3, 5 - 8, 10 -15 and 17 - 22 to issue.

In the event any additional fee is due, please charge our Deposit Account No. 13-0235 accordingly.

Respectfully submitted,

By



Donald J. MacDonald
Registration No. 42,823
Attorney for Appellant

McCormick, Paulding & Huber LLP
CityPlace II, 185 Asylum Street
Hartford, CT 06103-3402
(860) 549-5290